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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,682	09/17/2003	Masanori Sano	Q76998	2456

23373 7590 11/10/2005
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WASHINGTON, DC 20037

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,682

Applicant(s)

SANO ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Rejections Withdrawn

1. Claims 1-2 rejected under 35 U.S.C. 102(e) as being anticipated by Murata (2001/0055678 A1) made in the last Office Action of March 21, 2005 has been withdrawn in view of the amendment filed on August 22, 2005.
2. Claims 1-2 rejected under 35 USC 103(a) as being unpatentable over Carfagna in view of Murata has been withdrawn in view of the amendment.
3. Claim 4 rejected under 35 USC 103(a) as being unpatentable over Carfagna in view of Murata and Dreher has been withdrawn in view of the amendment.

Indicated allowability Withdrawn

4. Claim 3 indicated as being allowable in the last Office Action has been withdrawn in view of the newly discovered art to Kondo (6403215).

Response to Arguments

5. Applicant's arguments with respect to claims 1-2 and 4 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being obvious over Kondo (6403215) in view of Murata (2001/0055678).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Kondo relates to a pressure sensitive composition comprising an acrylic layer containing an isocyanate group-reacting functional group (col. 4, lines 6-27), a polyisocyanate based compound (col. 8, lines 35-37 and 48-50), and amine based compound containing plural hydroxyl groups (col. 7, lines 40-50). The adhesive composition is formed on a substrate (col. 12, lines 28-31). However, Kondo fails to

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teach the presence of thermally expandable microspheres in the composition. Murata relates to an expanded pressure sensitive adhesive layer (3) constituting of heat expandable microspheres (page-2, paragraph-0029), acrylic adhesive (page-3, paragraph-0031), and cross-linking additives such as polyisocyanates, etc. (page-3, paragraph-0030). The adhesive layer is formed on one surface of a substrate (2) (page-1, paragraph-0020). Murata teaches the advantage of providing thermally expandable microspheres to provide for lowering the adhesive density and adhesive force of the composition. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Murata's teaching of using thermally expandable microspheres in the adhesive composition of Kondo with the motivation to provide for lowered adhesive density and lower adhesive force for the composition.

Further, Murata also teaches that the adhesive can be of two or more layers (paragraph -[0043]) and that the composition can include antistatic agent (paragraph -[0042]). Therefore, it would have been obvious to one having ordinary skill in the art to having antistatic agent in the lower adhesive layer as the antistatic layer between the upper adhesive layer and the substrate.

The preamble phrase "A tacky dust cleaner" has not been given any patentable weight because it has been held that a preamble has been denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa V. Robie*, 88 USPQ 478 (CCPA

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1951). In this case, the structure of the expanded adhesive layer is a self-contained description of the structure.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being obvious over Kondo in view of Murata, Carfagna (6779976) and Dreher (3342325).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Kondo and Murata, as discussed above, fails to teach that the adhesive sheet composite is in a rolled state with adhesive on the outside of the substrate. Carfagna

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relates to a stack of dust cleaner sheet (abstract) having an expanded pressure sensitive adhesive layer (24) on one surface (the outside surface) of a substrate (22).

The adhesive comprises acrylic based adhesive with elastic microspheres (col. 4, lines 16-20). However, Carfagna fails to teach that the adhesive sheet is in a rolled state.

Dreher discloses a lint remover wherein the adhesive is provided on the outside of the sheet and the sheet can be in a rolled or stack form (figures 5-7). Dreher shows that stack and roll are equivalent structure known in the art. Therefore, because these two stack and roll were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute roll for stack. Hence, it would have been obvious to one having ordinary skill in the art to utilize Carfagna's teaching of providing the adhesive sheets in a stack form in the invention of Kondo and forming the stack into a roll form with the adhesive on the outside surface as taught by Dreher

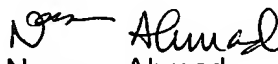
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 11/9/05
Primary Examiner
Art Unit 1772

N. Ahmad.
November 9, 2005.